

REMARKS

By the present response, Applicants traverse the rejection of Claims 1-18. Claims 1-18 remain pending in the present application. Claims 1, 12, and 17 are independent claims.

In the recent Office Action the Examiner rejected Claims 1-18 under 35 U.S.C. § 102(e) as being anticipated by Perkowski (U.S. Patent Publication No. 2003/0139975). This rejection is respectfully traversed.

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

Applicants note that the filing date of the Perkowski reference (December 12, 2002) is later than the filing date (March 9, 2001) and effective filing date (March 9, 2000) of the present application. Applicant notes that the cover page of the published application recites that the '975 application is a continuation of application Serial No. 09/465,859, filed December 17, 1999, now abandoned; however, the '859 application is not listed as an application from which priority is claimed in paragraph [0001] of the published application. For purposes of the present response, Applicants assume there is a valid claim for priority to the '859 made by the '975 application, and that the priority is properly designated as a "continuation," rather than a "continuation-in-part."

According to MPEP § 2131, in order to show anticipation under 35 U.S.C. § 102(e), the reference must show every element of the claimed invention identically. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed.

Serial No.: 09/801,854
Art Unit: 2151

Attorney Docket No. 18526.00
Confirmation No. 6306

Cir. 1986), *Akzo N.V. v. United States Intl. Trade Commission*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986). Not only must every element claimed be shown in the prior art reference, but every claimed limitation of each of the elements must be shown; otherwise, the only possible rejection is for obviousness under 35 U.S.C. § 103. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984), *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

In order to negate a rejection under 35 U.S.C. § 102(e), Applicants need only show that one element of the claimed invention is not shown by the reference. Applicants will therefore not describe every claim element or limitation missing from the reference, but only a single element that Applicants deem to be obviously missing in the reference, except as otherwise noted.

Paragraph (b) of independent Claim 1 of the present application claims, in relevant part, a relational database "...having means for establishing and maintaining an electronic mailbox for a plurality of clients." At pages 2-3 of the present Office Action, the Examiner cites references to various paragraphs of the Perkowski reference believed to show the corresponding elements of Claim 1 of the present application. However, with regard to paragraph (b) of Claim 1, the Examiner only cites paragraph [0038], and that only to show the relational database portion of paragraph (b). The only reference to an electronic mailbox in paragraph [0038] of Perkowski is a reference to manufacturers, distributors or merchants listing an existing e-mail address in a database record associated with a particular product,

the e-mail address being one accessed through the conventional Simple Mail Transfer Protocol (SMTP).

Applicants have reviewed the disclosure in Perkowski, and the only other references Applicants can locate relative to electronic mailboxes or e-mail refer to a kiosk that provides for saving links to Web documents providing consumer product information for bar-coded products in a preformatted e-mail message that can be sent to an e-mail address specified by the consumer, and that provides e-mail servers for retail sales establishments that collect copies of e-mails so transmitted for storage in the relational database for statistical analysis (see, e.g., paragraphs [0089]-[0092]; paragraphs [0119]-[0129]; and paragraphs [0239]-[0245]); a systems description calling for Post Office Protocol (POP3) e-mail client software for communication with similar remotely located e-mail client software via the Internet (paragraph [0231]); a description of the "electronic-mail" envelope procedure (paragraphs [0679]-[0690]), which explicitly clarifies that the Perkowski invention utilizes the consumer's pre-existing e-mail address (paragraph [0681]) and the retailer's pre-existing e-mail address (paragraph [0683]); and claims 7-12 and 39-42 of Perkowski.

Applicants are unable to find any language in the Perkowski reference describing a means for establishing and maintaining an electronic mailbox for a plurality of clients. Consequently, the Perkowski reference is deficient as an anticipatory reference under 35 U.S.C. § 102(e) with respect to Claim 1. Applicants respectfully submit that independent Claim 1 and corresponding dependent Claims 2-11 are allowable over the applied prior art of record.

Regarding independent Claim 12, paragraph (b) claims the element of “...establishing an electronic mailbox, assigning a unique mailbox ID, and a password for each client and recording the mailbox ID and password in the relational database.” At page 6 of the present Office Action, the Examiner cites paragraph [0175] of the Perkowski reference to show this element.

Applicants have carefully reviewed paragraph [0175] of the Perkowski reference. Applicants can find no reference to an act of establishing electronic mailboxes for each client; no reference to assigning a unique mailbox ID and password for each client; and no reference to recording the mailbox ID and password in paragraph [0175] of the Perkowski reference. The closest activity described in paragraph [0175] to the steps recited in the element at issue appears to be either the passage “a Electronic Trading Information Subsystem 4 for providing trading partners...to sell and purchase consumer goods by sending and receiving documents...to consummate purchase and sale transactions using either Value Added Network (VAN) based EDI transmission or Internet (e.g., HTTP, SMTP, etc.) based electronic document transmissions...”, or the passage “...and Input/Output Port Connecting Subsystems 8 for interconnecting the input and output ports of the above-identified subsystems through the infrastructure of the Internet and various value-added EDI networks of global extent...”, neither of which either explicitly or implicitly requires establishing electronic mailboxes, etc. As described above, Applicants can find no description of any of the above steps directed towards establishing and maintaining electronic mailboxes anywhere else in the Perkowski reference.

Consequently, the Perkowski reference is deficient as an anticipatory reference under 35 U.S.C. § 102(e) with respect to Claim 12. Applicants respectfully submit that independent Claim 12 and corresponding dependent Claims 13-16 are allowable over the applied prior art of record.

Regarding independent Claim 17, at pages 6-7 of the present Office Action, the Examiner claims that the Perkowski reference shows all of the elements of Claim 17. Applicants respectfully submit that the Perkowski reference shows none of the elements of Claim 17. For example, the preamble of Claim 17 indicates the claim is directed towards a method for transferring encrypted data, and the first element of Claim 17 recites “negotiating a sender’s initial header key between the sender and the server.” However, in the passage at pages 6-7 of the Office Action, the Examiner only recites the steps of Claim 12, and does not address the steps of Claim 17. At page 8 of the Office Action, the Examiner addresses a parallel limitation in dependent Claim 15, but does not cite a reference to Perkowski for the first element of Claim 17, unless the reference to paragraphs [0205] and [0317] is intended to cover both paragraphs (a) and (b) of Claim 15.

Paragraph [0205] of Perkowski refers to a “UPN-encoded” Java Applet. However, as indicated in paragraph [0204], the term “UPN-encoded” does not mean that the information conveyed by the Applet is encrypted, but merely that the Applet includes an appropriate HTTP tag that includes a UPN to identify or distinguish one Applet from another so that the transmitted Applet contains consumer product information corresponding to the product identified by that particular UPN.

Paragraph [0317] of Perkowski refers to a "UPN-encoded" servlet that is used to replace a CGI script for searching the relational database for retrieval of consumer product information relating to a particular product. The consumer selects a servlet tag graphically represented by an icon or image in an HTML-encoded document, and a servlet on the servers uses the UPN number to search the database for the corresponding document without having to use a complicated CGI script to search for various terms that may appear in the document, thereby speeding document retrieval.

In computer parlance, the term "encoded" is not synonymous with "encrypted." Computer programs are written in computer "code" that is well known to all computer programmers. Likewise, documents for transmission by the Hypertext Transfer Protocol (HTTP) have certain well-defined "codes" inserted into the document according to the Hypertext Markup Language (HTML). The text of document is not scrambled, but is perfectly intelligible to all readers; the documents are said to be "encoded" because they contain certain codes that cause a browser to perform certain well-defined actions.

In computer parlance, the term "encrypted" means that the text of the document has been scrambled so that the information is not intelligible to the casual viewer. Encryption, as applied to computer data transmission, generally involves both an algorithm (an agreed upon series of steps for manipulating the information that can be used for every document manipulated according to the algorithm) and one or more arbitrary keys that vary from message to message and that are utilized by the algorithm in scrambling the text.

Serial No.: 09/801,854
Art Unit: 2151

Attorney Docket No. 18526.00
Confirmation No. 6306

Paragraph (a) of Claim 17 refers to an encryption key. Applicants have carefully reviewed the Perkowski reference and have been unable to find any reference to encryption or the negotiation of an encryption key for the header of a message. Similarly, the remaining elements of Claim 17 are absent from the Perkowski reference.

Consequently, the Perkowski reference is deficient as an anticipatory reference under 35 U.S.C. § 102(e) with respect to Claim 17. Applicants respectfully submit that independent Claim 17 and corresponding dependent Claim 18 are allowable over the applied prior art of record.

It will be understood that there other elements of the independent claims not shown by the Perkowski reference, e.g., the immediate transfer of data to the receiving client when the receiving client is already connected to the server (Claims 1 and 12), elements (b)-(g) of independent Claim 17, etc. Applicant has limited discussion to a single element of each independent claim, as that is all that is required to overcome a 35 U.S.C. §102(e) rejection.

The remaining references cited by the Examiner, but not applied, do not supply the deficiencies of the Perkowski reference. The Scholl et al. reference (U.S. Patent No. 6,145,001) is directed towards a system and method for allowing a Web client to seamlessly access information on disparate managed networks, and does not describe establishing and maintaining electronic mailboxes or negotiating encryption keys. The Niemenen et al. reference (U.S. Patent No. 6,578,075) is directed towards a system and method for accessing various services in a public communications network, and does not describe establishing and maintaining electronic mailboxes or negotiating encryption keys. The Nieten reference

Serial No.: 09/801,854
Art Unit: 2151

Attorney Docket No. 18526.00
Confirmation No. 6306

(U.S. Patent No. 5,944,783) is directed towards an apparatus and method for information transfer among software agents operating simultaneously on a digital network and does not describe establishing and maintaining electronic mailboxes or negotiating encryption keys.

MPEP § 707.07(g) precludes piecemeal examination and provides that the examiner shall reject each claim on all valid grounds available. Applicants respectfully submit that since the only grounds for rejection cited by the Examiner are deficient, Claims 1-18 of the application are allowable over the prior art of record.

For the foregoing reasons, Applicants respectfully submit that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



Robert B. Lyons
Registration No. 40,708
(703) 486-1000

RBL:dht

Attachments: Petition for Extension of Time
Check in the amount of \$60.00